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Filing date: **10/15/2004**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91162022
Party	Defendant Meredith Corporation Meredith Corporation 1716 Locust Street Des Moines, IA 503093023
Correspondence Address	Mark Lerner Satterlee Stephens Burke & Burke LLP 230 Park Avenue Suite 1130 New York NY U, SA 10169
Submission	Answer and Counterclaim
Filer's Name	Mark Lerner
Filer's e-mail	mlerner@ssbb.com
Signature	/mark lerner/
Date	10/15/2004
Attachments	Sitt Answer and Counterclaim.pdf (13 pages) Sitt Exhibit A.pdf (13 pages) Sitt Exhibit b.pdf (2 pages) Sitt Exhibit c.pdf (4 pages) Sitt Exhibit D.pdf (7 pages)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

JOSEPH J. SITT,	:	
	:	Opposition No. 91162022
Opposer,	:	
	:	APPLICANT’S ANSWER TO
-against-	:	NOTICE OF OPPOSITION AND
	:	COUNTERCLAIM
MEREDITH CORPORATION,	:	
	:	
Applicant.	:	

TO THE HONORABLE ASSISTANT COMMISSIONER:

Meredith Corporation (“Applicant”), as and for its answer to the Notice of Opposition (“Notice”) filed by Joseph J. Sitt, (the “Opposer”), hereby states as follows:

FIRST: Admits the allegations contained in Paragraph 1 of the Notice.

SECOND: Denies the allegations contained in Paragraph 2 of the Notice of Opposition.

THIRD: Denies the allegations contained in Paragraph 3 of the Notice.

FOURTH: Denies the allegations contained in Paragraph 4 of the Notice.

FIFTH: Denies the allegations contained in Paragraph 5 of the Notice, except admits that Applicant’s mark, like Opposer’s Registered Mark, is comprised of the words “American Baby.”

SIXTH: Denies the allegations contained in Paragraph 6 of the Notice.

AS AND FOR A FIRST AFFIRMATIVE DEFENSE

SEVENTH: Applicant is the senior user of the mark since it has, through its predecessor in interest, used the mark AMERICAN BABY in commerce since at least as

early as 1938 in connection with a “magazine for expectant parents and parents of young children.”

AS AND FOR A SECOND AFFIRMATIVE DEFENSE

EIGHTH: Applicant is the owner of U.S. Reg. No. 1,496,741, dated July 19, 1988 for the mark AMERICAN BABY covering “magazine for expectant parents and parents of young children” in International Class 16. This registration is valid and subsisting and has become incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065. This registration pre-dates Opposer’s first use of its mark.

NINTH: Applicant is the owner of U.S. Reg. No. 1,729,325, dated November 3, 1992 for the mark AMERICAN BABY (Stylized) covering “magazine for expectant parents and parents of young children” in International Class 16. This registration is valid and subsisting and has become incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065. This registration pre-dates Opposer’s first use of its mark.

TENTH: Applicant is the owner of U.S. Reg. No. 1,908,875, dated August 3, 1995 for the mark AMERICAN BABY covering “entertainment services in the nature of a news and information television program” in International Class 41. This registration is valid and subsisting and has become incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065. Although this mark achieved registration after Opposer’s mark, Opposer did not object to the registration of this related mark.

ELEVENTH: Applicant is the owner of U.S. Reg. No. 2,550,825, dated March 19, 2002 for the mark AMERICAN BABY covering “Online retail services, namely, the dissemination of advertising and promotion of goods and services of others by means of an electronic marketplace accessible on the global computer network “ in International

Class 35; “chat room and bulletin board computer services, namely, providing on-line services for transmission of messages and interaction among other computer users concerning topics of interest to prospective parents and parents of young children” in International Class 38; and “computer services, namely, providing an on-line computer magazine devoted to prospective parents and parents of young children via the global computer network” in International Class 42. Although this mark achieved registration after Opposer’s mark, Opposer did not object to the registration of this related mark.

TWELFTH: The goods set forth in Applicant’s applications are a natural expansion of the goods and services offered by Applicant under the foregoing registrations.

THIRTEENTH: In light of the current practice of magazine publishers licensing their marks for a range of goods and services and Applicant’s own active brand licensing program, it is much more likely that consumers will assume that the goods listed in the applications originate with Applicant, than with Opposer.

AS AND FOR A THIRD AFFIRMATIVE DEFENSE

FOURTEENTH: There is no likelihood of confusion, mistake or deception as between the Applicant’s marks and Opposer’s mark because, *inter alia*, Applicant’s goods and services are sufficiently distinct from Opposer’s goods to eliminate any potential likelihood of confusion. Specifically, Opposer’s registration covers only “infants’ and children’s wearing apparel; namely, skirts, shirts, pants, coveralls, overalls, and dresses.” In stark contrast, Applicant’s marks cover goods wholly unrelated to “wearing apparel,” namely “nail clippers and baby scissors.” These goods are not remotely related to “wearing apparel” and consumers are not likely to believe that

Opposer is the source of these goods merely because Opposer purports to sell clothing under the mark.

AS AND FOR A FOURTH AFFIRMATIVE DEFENSE

FIFTEENTH: There is no likelihood of confusion, mistake or deception because Applicant and Opposer market and distribute their goods and services through different marketing channels.

AS AND FOR A FIFTH AFFIRMATIVE DEFENSE

SIXTEENTH: This opposition is barred by the doctrines of laches, waiver, estoppel and/or acquiescence.

AS AND FOR A SIXTH AFFIRMATIVE DEFENSE

SEVENTEENTH: Opposer's registration is invalid because the Opposer was not using the mark in commerce in the year preceding May 18, 2003 – the tenth anniversary of the registration of applicant's mark.

EIGHTEENTH: Despite Opposer's lack of use of the mark, in January 2003, Registrant filed a fraudulent affidavit under Sections 8 & 9 of the Trademark Act, 15 U.S.C. §§ 1058 & 1059, declaring that he was using the mark in commerce, when, in fact, he had not made legitimate use of the Mark in commerce for over two years.

NINETEENTH: In particular, Opposer has admitted that neither it nor a licensee sold any goods in commerce under the mark in 2002 or 2003.

NINETEENTH: Opposer's registration is thus invalid and Opposer is not entitled to any presumption of exclusive right to use the mark in connection with wearing apparel.

AS AND FOR A SEVENTH AFFIRMATIVE DEFENSE

TWENTIETH: By virtue of Opposer's three years of not-use without an intent to resume use, the Opposer has abandoned its mark.

COUNTERCLAIM

Meredith Corporation, a corporation organized under the laws of Iowa, with its principal place of business at 1716 Locust Street, Des Moines, Iowa 50309, believes that it will be, and is being damaged by the registered mark AMERICAN BABY (Reg. No. 1,772,408) International Class 25 and as its counterclaim against Opposer alleges as follows:

SUMMARY OF THE CASE

TWENTY-FIRST: Petitioner is the assignee of valid, incontestable registrations for the mark AMERICAN BABY, and the publisher of the famous AMERICAN BABY magazine. Meredith acquired the marks and the related business from Primedia Magazine Finance Inc. ("Primedia") in December 2002. AMERICAN BABY magazine has been published since 1938. The first of several registrations for the AMERICAN BABY mark was granted to Meredith's predecessor in 1988. Over the years, the use of the AMERICAN BABY mark has extended from magazines to television programs, to online services. Most recently, Meredith and its predecessor laid the groundwork to expand the brand further into a wide range of baby-related goods, filing numerous intent-to-use applications for the mark in connection with an array of products and services.

TWENTY-SECOND: Registrant, Joseph J. Sitt ("Registrant" or "Sitt"), is the purported owner of Registration No. 1,772,408 for the mark AMERICAN BABY,

granted in 1993 in connection with “infants’ and childrens’ [sic] wearing apparel; namely, skirts, shirts, pants, coveralls, overalls, and dresses” (the “Mark”).

TWENTY-THIRD: Upon information and belief, Registrant ceased use of the Mark in November 2000. Upon further information and belief, in late 2002, Registrant learned from public reports of Meredith’s impending acquisition of the AMERICAN BABY marks and magazine business from Primedia. He thus saw a means of generating a revenue stream from his defunct mark and undertook to buttress his ownership of the Mark in order to be in a position to demand compensation from Meredith for transfer of the Mark or to enter into a business relationship with Meredith pursuant to which it would pay him royalties for its expanding use of its AMERICAN BABY mark.

TWENTY-FOURTH: To that end, in November 2002, Registrant contacted Meredith to try to stop its impending purchase of the American Baby business by threatening to take legal action if Meredith used the mark in connection with baby-related goods beyond the magazines, online services and television programs. He also threatened to oppose the pending intent-to-use applications that had been filed by Primedia. He claimed that prior to preparing for the sale of the business, Meredith’s predecessor had been willing to pay Registrant a lucrative sum to purchase the Mark, but that the predecessor had ultimately withdrawn from such discussions. According to Primedia, it had never been willing to pay Registrant for the Mark. Registrant suggested that he would be willing to discuss entering an agreement with Meredith for sale of the Mark or a license. Meredith did not agree to negotiate with Registrant, or to stop its acquisition of the AMERICAN BABY business.

TWENTY-FIFTH: In January 2003 – shortly after Meredith completed its acquisition of the American Baby business – Registrant filed a fraudulent affidavit under Sections 8 & 9 of the Trademark Act, 15 U.S.C. §§ 1058 & 1059, declaring that he was using the mark in commerce, when, in fact, he had not made legitimate use of the Mark in commerce for over two years. As set forth more fully below, Registrant has thus maintained the registration of the AMERICAN BABY mark by fraud.

TWENTY-SIXTH: In or about April, 2003, after he filed his fraudulent Section 8 affidavit, Registrant again contacted Meredith to threaten action if Meredith did not either compensate him or enter into an agreement with him, but continued with plans to expand use of the AMERICAN BABY mark as per the numerous intent-to-use applications it filed in the Patent and Trademark Office (“PTO”) in December 2002. Again, Meredith declined to negotiate with Registrant.

TWENTY-SEVENTH: In December 2003, after more than three years of non-use of the Mark, Registrant filed oppositions to a wide range of pending applications filed by Meredith and its predecessor in order to convince Meredith to purchase the Mark from him, enter into a licensing deal or otherwise compensate him.

TWENTY-EIGHTH: Thus, upon information and belief, Registrant has not made genuine use of the Mark in commerce since November 2000, but has fraudulently attempted to maintain his registration. Accordingly, for the reasons set forth more fully below, Petitioners submit that Registrant’s registration should be cancelled.

THE TRADEMARKS AT ISSUE

TWENTY-NINTH: Petitioner Meredith Corporation is the owner of the trademark registration for the marks AMERICAN BABY (Reg. Nos. 1,496,741,

1,908,875, 2,550,825) and AMERICAN BABY (Stylized) (Reg. No. 1,729,325).

Meredith also owns the related registrations for marks AMERICAN BABY'S FIRST YEAR OF LIFE (Reg. No. 1,530,835) and AMERICAN BABY BASKET (Reg. No. 1,893,287). Copies of printouts of information on the relevant registrations from the PTO's TESS database are annexed hereto as Exhibit A.

THIRTIETH: Registration numbers 1,496,741, 1,729,325 and 1,908,875 are incontestable.

THIRTY-FIRST: Meredith has been using the AMERICAN BABY marks in interstate commerce in connection with magazines since at least as early as 1938. The mark has been used in connection with a news and information television program since 1981 and in connection with online retail services, an online magazine and online bulletin boards since 1999.

THIRTY-SECOND: The AMERICAN BABY Marks have been in valid and continuous use since their respective dates of first use and have not been abandoned.

THIRTY-THIRD: Prior to Meredith's acquisition of the registered marks and the related business in December 2002, its predecessor had filed two intent-to-use applications for the mark AMERICAN BABY in a stylized form. The marks were proposed for use in connection with a wide variety of goods and services. Meredith acquired these applications (Serial Nos. 76/296,653, 78/145,258) along with the business and registered marks.

THIRTY-FOURTH: Upon its acquisition of the business from Primedia, Meredith filed eleven intent-to-use applications for the mark AMERICAN BABY in connection with a wide array of baby-related products.

THIRTY-FIFTH: Registrant claims ownership of the trademark registration for the mark AMERICAN BABY (Reg. No. 1,772,408).

EVIDENCE OF THE REGISTRANT'S FRAUD

THIRTY-SIXTH: Upon information and belief, on or about January 13, 2003, Registrant filed a Combined Declaration of Use in Commerce/Application for Renewal of Federal Registration of Mark Under §§ 8 & 9 (15 U.S.C. §§ 1058 & 1059). The declaration states, in relevant part, as follows: "The undersigned declares that the owner is using the mark in commerce on or in connection with all of the goods and/or services listed in the existing registration as evidence by the attached specimen(s) showing the mark as currently used." The declaration is signed by the registrant, Joseph J. Sitt. A copy of the affidavit is annexed hereto as Exhibit B.

THIRTY-SEVENTH: On or about March 20, 2003, the United States Patent and Trademark Office ("PTO") issued a Post Registration Office Action in which it refused the Section 8 affidavit because the specimen submitted did not show actual use of the mark in commerce. In fact, according to the PTO, the specimen that had been submitted was merely an "artist's rendering of the mark, rather than an actual photograph." A copy of the Post Registration Office Action is annexed hereto as Exhibit C.

THIRTY-EIGHTH: Upon information and belief, Registrant responded to the office action on or about May 19, 2003 by filing a substitute specimen and response. In the response, registrant claimed that the substitute specimen consisted of a hang tag and a label "used on the goods in commerce." Included with the response was a declaration that stated, in relevant part: "The Registrant was using the mark in commerce on or in connection with the goods identified in the registration for which use of the mark in

commerce is claimed, as evidence by the submitted specimen, during the relevant period for filing the 10-year Section 8, that is, within the one year preceding the end of a 10-year period after the date of registration.” The declaration is signed by the attorney for the Registrant. A copy of the affidavit is annexed hereto as Exhibit D.

THIRTY-NINTH: The initial Section 8 affidavit filed made no reference to the fact that the mark was not presently in use, but, rather, had purportedly been in use at some time during the year preceding the filing of the declaration.

FOURTIETH: Upon information and belief, the Mark was neither in use on January 13, 2003 when the initial declaration was filed, nor on May 19, 2003 when the response was filed, nor even at any time during the tenth year of registration of the mark, that is, between May 18, 2002 and May 18, 2003.

FORTY-FIRST: On December 11, 2003, Registrant filed a Notice of Opposition against Meredith seeking refusal of the registration of a range of applications to register the mark AMERICAN BABY (Opposition No. 91158912).¹ The opposition was based on Registrant’s alleged ownership of the Mark and the alleged likelihood of confusion between the marks applied for by Meredith and the Mark.

FORTY-SECOND: In connection with that proceeding, Registrant has responded to Requests for Admission and Interrogatories. In those responses, Registrant has admitted that it terminated the only existing license to use the Mark in November 2000 and did not resume use of the mark until 2004. Moreover, it admitted that neither it nor its licensee sold any goods under the Mark in 2002 or 2003.

¹ Petitioner respectfully suggests that because the Mark is the basis for Registrant’s opposition to Meredith’s pending applications and, if the mark is deemed to be invalid, Registrant will not be entitled to the presumptions otherwise conferred by registration, the Opposition proceeding should be stayed pending the outcome of this cancellation petition.

FORTY-THIRD: Specifically its responses to certain Requests to Admission and Interrogatories were as follows:

Request for Admission No. 4: [Registrant] or its licensee did not sell any goods under the Mark in calendar year 2002.

Response to Request for Admission No. 4: Admitted

Request for Admission No. 5: [Registrant] or its licensee did not sell any goods under the Mark in calendar year 2003.

Response to Request for Admission No. 5: Admitted.

* * * *

Interrogatory No. 25: Identify any periods of time since 1992 during which no goods were sold under the Mark.

Interrogatory Response No. 25: Sitt left Urban Brands in November 2000, and Urban Brands' license then terminated . . . Sales did not resume until 2004.

FORTY-FOURTH: Registrant has thus acknowledged that it did not use the mark in commerce during the one year period from May 18, 2002 to May 18, 2003 necessary to truthfully file a Section 8 declaration. Nonetheless, it filed two separate declarations swearing that it was using, or had used the Mark during the required time period. Clearly the Registrant was aware that it was not using the Mark at that time, but nonetheless filed fraudulent declarations in order to be able to maintain its registration so that it could further its overall objective of forcing Meredith to negotiate some compromise as to its expanded use of the AMERICAN BABY mark.

FORTY-FIFTH: Upon information and belief, Registrant could not have even properly filed a declaration of excusable non-use under Section 8. According to § 1604.11 of the TMEP, such an affidavit must specify the reasons for the non-use and the

steps being taken to bring the mark back into the marketplace. “[M]erely stating that there is no intention to abandon the mark is not enough. The affidavit or declaration must recite facts and circumstances that clearly demonstrate that nonuse is due to special circumstances that excuse the nonuse.” Upon information and belief, Registrant simply terminated a license to a licensee in November 2000 and ceased production. Upon information and belief, it made no effort to bring the product back to market until early 2004. In early 2004, Baby Togs, Inc., the licensee through which Registrant purported to sell goods under the Mark, responded to inquiries about the brand noting that no such brand was currently sold or had been sold, but that it was anticipated that a new line under that brand would be available some time in the spring of 2004. Upon information and belief, even then, the efforts to bring product to market under the Mark were being undertaken solely to support Registrant’s opposition and to convince Meredith to enter negotiations.

REGISTRANT’S ABANDONMENT OF THE MARK

FORTY-SIXTH: Upon information and belief, evidence will demonstrate that even during the 1990s, when the mark was purportedly in use, neither Registrant, nor its licensees regularly sold any goods under the Mark.

FORTY-SEVENTH: Moreover, in addition to having defrauded the PTO, Sitt should be deemed to have abandoned the Mark. Upon information and belief, during a three year period the Mark was not in use and Registrant had no genuine intent during that period to resume use.

CONCLUSION

FORTY-EIGHTH: Registrant’s mark should be cancelled because:

a. Registrant obtained renewal of its registration based upon fraudulent and deceptive statements in its submissions to the PTO;

b. Registrant abandoned its mark.

WHEREFORE, Petitioner deems that it is or will be damaged by Reg. No. 1,772,408 and petitions for cancellation thereof.

Dated: October 15, 2004
New York, New York

Respectfully submitted,

/mark lerner/
Robert M. Callagy
Mark Lerner
Satterlee Stephens Burke & Burke LLP
Attorneys for Applicant
MEREDITH CORPORATION
230 Park Avenue
New York, New York 10169
(212) 818-9200

CERTIFICATE OF MAILING

I hereby certify that a true and correct copy of this answer and counterclaim was deposited with the United States Postal Service as first class mail in an envelope addressed to James B. Swire, Dorsey & Whitney LLP, 250 Park Avenue, New York, New York 10177 on October 15, 2004.

/mark lerner/
Mark Lerner

EXHIBIT A



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Typed Drawing

Word Mark	AMERICAN BABY
Goods and Services	IC 016. US 038. G & S: MAGAZINE FOR EXPECTANT PARENTS AND PARENTS OF YOUNG CHILDREN. FIRST USE: 19380000. FIRST USE IN COMMERCE: 19380000
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73695950
Filing Date	November 13, 1987
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	April 26, 1988
Registration Number	1496741
Registration Date	July 19, 1988
Owner	(REGISTRANT) REED PUBLISHING (USA) INC. CORPORATION MASSACHUSETTS SUITE 1300, 1105 N. MARKET STREET WILMINGTON DELAWARE 19899 (LAST LISTED OWNER) REED PROPERTIES INC. CORPORATION ASSIGNEE OF DELAWARE SUITE 1300, 1105 N. MARKET ST. WILMINGTON DELAWARE 19899
Assignment Recorded	ASSIGNMENT RECORDED
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BABY" APART FROM THE MARK AS SHOWN

Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

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Typed Drawing

Word Mark	AMERICAN BABY
Goods and Services	IC 041. US 107. G & S: entertainment services in the nature of a news and information television program. FIRST USE: 19810100. FIRST USE IN COMMERCE: 19810100
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74424444
Filing Date	August 16, 1993
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	February 7, 1995
Registration Number	1908875
Registration Date	August 1, 1995
Owner	(REGISTRANT) Reed Properties Inc. CORPORATION DELAWARE 1105 N. Market Street Suite 1221 Wilmington DELAWARE 19801 (LAST LISTED OWNER) PRIMEDIA MAGAZINE FINANCE INC. CORPORATION BY CHANGE OF NAME, BY ASSIGNMENT, BY CHANGE OF NAME DELAWARE 717 5TH AVENUE NEW YORK NEW YORK 10022
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of	BAILA H. CELEDONIA

Record

Prior Registrations	1496741;1729325
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BABY" APART FROM THE MARK AS SHOWN
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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Typed Drawing**Word Mark** AMERICAN BABY**Goods and Services** IC 035. US 100 101 102. G & S: Online retail services, namely, the dissemination of advertising and promotion of goods and services of others by means of an electronic marketplace accessible on the global computer network. FIRST USE: 19990500. FIRST USE IN COMMERCE: 19990500

IC 042. US 100 101. G & S: computer services, namely, providing an on-line computer magazine devoted to prospective parents and parents of young children via the global computer network. FIRST USE: 19990500. FIRST USE IN COMMERCE: 19990500

IC 038. US 100 101 104. G & S: chat room and bulletin board computer services, namely, providing on-line services for transmission of messages and interaction among other computer users concerning topics of interest to prospective parents and parents of young children. FIRST USE: 19991000. FIRST USE IN COMMERCE: 19991000

Mark Drawing Code (1) TYPED DRAWING**Serial Number** 75901884**Filing Date** January 21, 2000**Current Filing Basis** 1A**Original Filing Basis** 1B**Published for Opposition** June 12, 2001**Registration Number** 2550825

Registration Date March 19, 2002

Owner (REGISTRANT) PRIMEDIA Magazine Finance Inc. CORPORATION DELAWARE 717 Fifth Avenue New York NEW YORK 10022

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record BAILA H. CELEDONIA

Prior Registrations 1496741;1530835;1729325;1893287;1900595;1900596;1908875

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BABY" APART FROM THE MARK AS SHOWN

Type of Mark SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Use the "Back" button of the Internet Browser to return to TESS)*

Word Mark	AMERICAN BABY
Goods and Services	IC 016. US 038. G & S: magazine for expectant parents and parents of young children. FIRST USE: 19920101. FIRST USE IN COMMERCE: 19920101
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	74253528
Filing Date	March 9, 1992
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	August 11, 1992
Registration Number	1729325
Registration Date	November 3, 1992
Owner	(REGISTRANT) Reed Properties Inc. CORPORATION DELAWARE 1105 N. Market Street Suite 1221 Wilmington DELAWARE 19801 (LAST LISTED OWNER) PRIMEDIA MAGAZINE FINANCE INC. CORPORATION BY CHANGE OF NAME FROM DELAWARE 260 MADISON AVE NEW YORK NEW YORK 10016

Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	SUJATA CHAUDHRI
Prior Registrations	1496741;1528218;1530835
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BABY" APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20021005.
Renewal	1ST RENEWAL 20021005
Live/Dead Indicator	LIVE

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Typed Drawing

Word Mark	AMERICAN BABY'S FIRST YEAR OF LIFE
Goods and Services	IC 016. US 038. G & S: MAGAZINE FOR EXPECTANT PARENTS AND THE PARENTS OF YOUNG CHILDREN. FIRST USE: 19780000. FIRST USE IN COMMERCE: 19780000
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73734449
Filing Date	June 15, 1988
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	December 27, 1988
Change In Registration	CHANGE IN REGISTRATION HAS OCCURRED
Registration Number	1530835
Registration Date	March 21, 1989
Owner	(REGISTRANT) REED PUBLISHING (USA) INC. CORPORATION MASSACHUSETTS 275 WASHINGTON STREET NEWTON MASSACHUSETTS 02158 (LAST LISTED OWNER) REED PROPERTIES INC. CORPORATION ASSIGNEE OF DELAWARE SUITE 1300 1105 NORTH MARKET STREET WILMINGTON DELAWARE 19801

Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	JOHN D. FAIRCHILD
Prior Registrations	1496741
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BABY'S FIRST YEAR OF LIFE" APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

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*(TARR contains current status, correspondence address and attorney of record for this mark.
Use the "Back" button of the Internet Browser to return to TESS)*

Typed Drawing

Word Mark	AMERICAN BABY BASKET
Goods and Services	IC 035. US 101. G & S: promoting the goods and services of others through the distribution of product samples of interest to parents of infants or expecting parents. FIRST USE: 19840100. FIRST USE IN COMMERCE: 19840100
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74424755
Filing Date	August 16, 1993
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	February 14, 1995
Registration Number	1893287
Registration Date	May 9, 1995
Owner	(REGISTRANT) Reed Properties Inc. CORPORATION DELAWARE 1105 N. Market Street Suite 1221 Wilmington DELAWARE 19801 (LAST LISTED OWNER) PRIMEDIA MAGAZINE FINANCE INC. CORPORATION BY CHANGE OF NAME, BY ASSIGNMENT, BY CHANGE OF NAME DELAWARE 717 FIFTH AVENUE NEW YORK NEW YORK 10022
Assignment Recorded	ASSIGNMENT RECORDED

Prior Registrations 1496741;1729325

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BABY BASKET" APART FROM THE MARK AS SHOWN

Type of Mark SERVICE MARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

Live/Dead Indicator LIVE

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EXHIBIT B

#5

UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

To Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Mark: AMERICAN BABY
Registration No: 1772408
Registration Date: 5/18/93

COMBINED DECLARATION OF USE IN COMMERCE/
APPLICATION FOR RENEWAL OF FEDERAL REGISTRATION OF MARK
UNDER §§ 8 & 9 (15 U.S.C. §§ 1058 & 1059)

Joseph J. Sitt being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

The undersigned declares that the owner is using the mark in commerce on or in connection with all of the goods and/or services listed in the existing registration as evidenced by the attached specimen(s) showing the mark as currently used.

The owner/registrant requests that the registration be renewed for the goods and/or services identified above.

Joseph J. Sitt,
a United States citizen
460 West 34th Street 15th Floor
New York NY 10001

By: 

Date 1/13/03

Joseph J. Sitt, Owner

Typed Name and Position

02/06/2003 K5IB90NS 00000027 1772408

01 FC:6205
02 FC:6201

100.00 OP
400.00 OP

Certificate of Mailing

Date of Deposit.....
I hereby certify that on the date indicated above, I deposited with the United States Postal Service as First Class mail, postage prepaid, in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Typed Name of person mailing

Signature of person mailing

S 00084

EXHIBIT C

UNITED STATES PATENT AND TRADEMARK OFFICE

REGISTRATION NO: 1,772,408

March 30, 2003

REGISTRANT: Sitt, Joseph J.

CORRESPONDENT ADDRESS:
JOSEPH J. SITT
460 WEST 34TH STREET, 15TH FLOOR
NEW YORK, NEW YORK 10001

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
TMPostRegistration@uspto.gov

MARK: AMERICAN BABY

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:
N/A

Please provide in all correspondence:

1. Registration date, registration number, mark and registrant's name.
2. Date of this Office Action.
3. Examiner's name and Post Registration Division.
4. Your telephone number and e-mail address.

POST REGISTRATION OFFICE ACTION

RE: Registration Number 1,772,408

The Combined Section 8 Affidavit and Section 9 Renewal Application was received on January 28, 2003. Renewal can be granted. However, the Section 8 Affidavit is refused for the following reason(s):

The specimen submitted does not show actual trademark use. Although the specimen shows a picture of the goods with the mark, the picture appears to be an artist's rendering of the mark, rather than an actual photograph.

The owner must submit a substitute specimen showing actual trademark use, such as a tag or a label used on the goods or an actual photograph of the mark as used on the goods. 37 C.F.R. §2.161(g)(1). The owner also must submit a declaration in accordance with 37 C.F.R. §2.20 that the substitute specimen was in use in commerce during the relevant period for filing the 10-year Section 8.

To verify the information required above, the owner must submit a substitute affidavit or declaration in accordance with 37 C.F.R. §2.20. The following is a properly worded declaration in accordance with 37 CFR §2.20.

The owner was using the mark in commerce on or in connection with the goods identified in the registration for which use of the mark in commerce is claimed, as evidenced by the submitted specimen, during the relevant period for filing the 10-year Section 8, that is, *within one year before the end of a 10-year period after the date of registration.*

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statement may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature

Typed or Printed Name

Date

A COMPLETE RESPONSE MUST BE RECEIVED WITHIN 6 MONTHS FROM THE MAILING DATE OF THIS OFFICE ACTION OR BEFORE MAY 18, 2003, THE REGISTRATION EXPIRATION DATE, WHICHEVER IS LATER. THE OWNER MUST COMPLY WITH ALL REQUIREMENTS SET FORTH IN THIS LETTER TO AVOID CANCELLATION AND/OR EXPIRATION OF THE REGISTRATION.

DEFICIENCY SURCHARGE: A \$100 DEFICIENCY SURCHARGE MUST BE PAID IF THE RESPONSE IS RECEIVED AFTER MAY 18, 2003, THE REGISTRATION EXPIRATION DATE.

PLEASE BE ADVISED THAT IF THE WRONG PARTY FILED THE SECTION 8 AFFIDAVIT, THE CURRENT OWNER MUST FILE A NEW AFFIDAVIT BEFORE THE GRACE PERIOD EXPIRES AND PAY THE FEE FOR FILING THE NEW AFFIDAVIT. THE OWNER MUST ALSO PAY THE GRACE PERIOD FEE, IF THE NEW AFFIDAVIT IS FILED DURING THE GRACE PERIOD.

Dana D. Latham

Dana D. Latham
Paralegal Specialist
Office of Trademark Services
Post Registration Division
(703) 308-9500 Ext. 248
(703) 872-9257 Fax
TMPostRegistration@uspto.gov

How to respond to this Office Action:

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the registration number, the words 'Post Registration' and the examiner's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT
THE ASSIGNED EXAMINER.**

EXHIBIT D

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Registrant: Joseph J. Sitt

Mark: AMERICAN BABY Paralegal Specialist: Dana D. Latham

Reg. Date: May 18, 1993 Post Registration Division

Reg. No. 1,772,408 Our Reference No: 462204-2

Office of Trademark Services Post Registration Division
2900 Crystal Drive
Arlington, VA 22202-3513

RESPONSE AND AMENDMENT

In a Post Registration Office Action mailed March 30, 2003, Paralegal Specialist refused the Section 8 Affidavit because the specimen submitted does not show actual trademark use. Registrant submits the following Response.

Substitute Specimen

Registrant attaches herewith a substitute specimen that shows the mark as used by the registrant. The specimens consist of a hang tag and a label used on the goods in commerce. Registrant attaches herewith the requisite Declaration in accordance with 37 C.F.R. § 2.20.

CONCLUSION

In light of the foregoing Response, it is respectfully requested that Examiner approve the Application for renewal.

Respectfully submitted,

DORSEY & WHITNEY LLP



Bruce Ewing
250 Park Avenue
New York, New York 10177
(212) 415-9200
Attorneys for Registrant

DECLARATION

The Registrant was using the mark in commerce on or in connection with the goods identified in the registration for which use of the mark in commerce is claimed, as evidenced by the submitted specimen, during the relevant period for filing the 10-year Section 8, that is, within one year before the end of a 10-year period after the date of registration.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of this document, declares: that he is properly authorized to execute this Declaration on behalf of the Registrant; and all statements made of his own knowledge are true and that statements made on information and belief are believed to be true.

Date: May 19, 2003

DORSEY & WHITNEY LLP



Bruce Ewing
250 Park Avenue
New York, New York 10177
(212) 415-9200
Attorneys for Registrant

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that on the date indicated below, this correspondence is being deposited with the United States Postal Service with sufficient postage as Express mail, under 37 CFR 1.8 and is addressed to: Office of Trademark Services Post Registration Division, 2900 Crystal Drive, Arlington, VA 22202-3513.

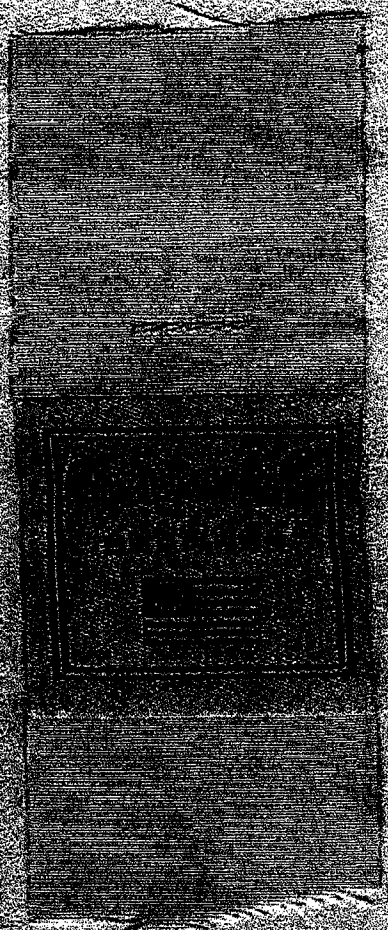
"Express Mail" Mailing Number: EV 095992771 US

Date of Deposit: May 19, 2003

Name: Linda Leone

Name: Linda Leone

Signature: Linda Leone





EV 095992771 US

Mailing Label
Label 11-F October 2001

UNITED STATES POSTAL SERVICE®

Post Office To Addressee

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Date In Mo. Day Year	<input type="checkbox"/> 12 Noon <input type="checkbox"/> 3 PM	Postage \$	Delivery Attempt	Time <input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature
Time In <input type="checkbox"/> AM <input type="checkbox"/> PM	Military <input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day	Return Receipt Fee	Delivery Date	Time <input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature
Weight lbs. ozs.	Int'l Alpha Country Code	COD Fee Insurance Fee			
No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday	Acceptance Clerk Initials	Total Postage & Fees \$			
CUSTOMER USE ONLY METHOD OF PAYMENT: Express Mail Corporate Acct. No. 462204-2			Federal Agency Acct. No. or Postal Service Acct. No.		
FROM: (PLEASE PRINT) DORSEY & WHITNEY 250 PARK AVE FL 15 NEW YORK NY 10177-1500 Bruce Ewing			TO: (PLEASE PRINT) COMMISSIONER FOR TRADEMARK 2900 CRYSTAL DR ARLINGTON VA 22202-3514 Office of Trademark Services Post REG Division		
PRESS HARD. You are making 3 copies. FOR PICKUP OR TRACKING CALL 1-800-222-1811 www.usps.com					

S 00072

Postcard addressed to Dorsey & Whitney LLP
RECEIPT ACKNOWLEDGED FOR:

Applicant/Registrant:	Joseph Sitt		
Serial No./Reg. No.	1,772,408		
Mark:	AMERICAN BABY		
Class(es):	25	Filing/Reg. Date:	5/18/93
<input type="checkbox"/> Trademark Application	<input type="checkbox"/> ITU <input type="checkbox"/> USE <input type="checkbox"/> § 44	<input type="checkbox"/> Sec. 8 Affidavit of Use	
<input checked="" type="checkbox"/> Declaration		<input type="checkbox"/> Sec. 15 Affi. of Incontestability	
<input type="checkbox"/> App. of Domestic Rep.		<input type="checkbox"/> Sec. 9 Renewal	
<input type="checkbox"/> Amendment to Allege Use		<input type="checkbox"/> Assignment of Change of Name	
<input type="checkbox"/> Statement of Use		<input type="checkbox"/> Notice of Opp.	
<input checked="" type="checkbox"/> Specimens: Substitute		<input type="checkbox"/> Petition for Cancellation	
<input type="checkbox"/> Check No. Amount		<input checked="" type="checkbox"/> Response (or Amendment) to OA Post Reg	
<input type="checkbox"/> Request for Ext. to File SOU No.		<input type="checkbox"/> Opposition Ex. Request No.	
Our Reference No.	462204-2		
<input type="checkbox"/> Expressmail Label No.	EV 095992771 US	First Class Mail	Date: 5/19/03